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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,592	01/14/2002	R. Michael Gross		3738

7590 07/26/2004  
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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/046,592

Applicant(s)

GROSS, R. MICHAEL

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/12/04 has been entered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "tube having an arcuate portion" must be shown or the feature(s) canceled from the claim(s). The figures show an "angular portion". No new matter should be entered.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Bilweis (5196003). Fig. 1 shows a tool having an elongated tube **10** with an outer surface and a proximal end in communication with a suction mechanism **17**. It can also be seen there is a sleeve **20** that is slidably coupled to the outer surface of the elongated tube. Additionally, Bilweis discloses a sealing surface **24** at the distal end of the sleeve that permits sealing the suction cup to the body tissue. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Clearly, the device is capable of drawing material into a body cavity by forming a negative pressure and suction.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3,4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelman (5417654) in view of Dubinsky (WO 99/52441). Kelman discloses a tool (Fig. 3) with a hollow tube **18** having a distal arcuate portion **50**. Kelman also discloses the tube is made of a rigid material, col. 5, lines 10-13. Fig. 6 shows the tube **36** with a connection end **38** that is capable being joined with a suction mechanism, col. 5, lines 40-45. Fig. 3 also illustrates the tool has a sleeve **16** slidably mounted on the tube. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. However, Kelman fails to disclose a gasket operatively coupled on the distal end of the sleeve. Dubinsky teaches (Fig. 1A) a tool with a sleeve having a gasket **132** operatively coupled thereon. Dubinsky teaches the

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sealing means or gasket is used to seal a passage to help retain body material, page 12, lines 8-10,18-20. It would have been obvious to one of ordinary skill in the art to use a gasket as taught by Dubinsky with the tool of Kelman such that it prevents debris from escaping the cavity and aids in forming a negative pressure to form a good vacuum. Regarding claim 4, it would have been an obvious matter of design choice to modify the distal end of the tool to be angular, since applicant has not disclosed that using an angular end provides any advantage, or solves a stated problem, or is used for any particular purpose. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the arcuate end taught by Kelman or the claimed angular end in claim(s) 4 because both ends perform the same function of permit the surgeon to enter a cavity that is indirectly accessible of offset from the entry site.

Claims 2,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelman '654 in view of Dubinsky (WO 99/52441 as applied to claim 1 above, and further in view of Lee et al. (5693030). Kelman in view of Dubinsky is explained supra. However, Kelman as modified by Dubinsky fail to disclose openings in the tip of the tube and an obturator. Lee et al. teach (Fig. 1) a tube with a distal portion having a plurality of openings **32** therein for greater communication with the channel in the tube. Lee also teaches (Fig. 3) an obturator **60** that may be extended in the tube that is fully capable of clearing debris. It would have been obvious to one of ordinary skill in the art to use a plurality of openings and an obturator as taught by Lee et al. with the tool of Kelman as modified by Dubinsky such that greater suction or pressure can be created with more

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openings and the obturator provides the ability of the surgeon to free up any unloose debris.

***Response to Arguments***

Applicant's arguments filed 4/12/04 have been fully considered but they are not persuasive with respect to the drawing objection because the specification states on page 3, lines 17,18 that Figs. 1 and 2 are the same embodiment. Therefore, the objection is maintained. Applicant's arguments with respect to claims 1 and 8 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8:30am to 6pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

TC 3700, AU 3738

Brian E. Pellegrino

A handwritten signature in black ink that reads "Brian E. Pellegrino". The signature is written in a cursive, flowing style with a large initial "B".